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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,438	09/23/2003	David Milstein	M61.12-0545	2338
27366 7590 05/15/2007 WESTMAN CHAMPLIN (MICROSOFT CORPORATION) SUITE 1400 900 SECOND AVENUE SOUTH MINNEAPOLIS, MN 55402-3319			EXAMINER BENGZON, GREG C	
			ART UNIT 2144	PAPER NUMBER
			MAIL DATE 05/15/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/668,438

Applicant(s)

MILSTEIN ET AL.

Examiner

Greg Bengzon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 01/20/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This application has been examined. Claims 1-59 are pending.

#### ***Priority***

The effective date of the claims described in this application is September 23, 2003.

#### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 01/20/2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-59 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-59 recite a limitation for '*a specialized entity*'. The term '*specialized entity*' is a relative term which renders the claim indefinite. The term *specialized entity* is not defined by the claim, the specification does not provide a standard for

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ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2,6,15-19,21-27,34-37,39-44,52-55, 57-59 rejected under 35

U.S.C. 102(e) as being anticipated by Leber (US Publication 2003/0182391).

Leber disclosed (re. Claim 1,26,39,40,42, 57-58) a computer implemented method for task execution based on dialog-based communication with a communication service, comprising: receiving dialog from a user, the dialog being directed to a specialized entity (Leber-Paragraph 67, 'chat box') ; analyzing the dialog to identify a

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command; (Leber-Paragraph 68) and performing a task on the user's behalf based on the command. (Leber-Paragraph 67)

Leber disclosed (re. Claim 2,27,43) wherein analyzing the dialog to identify a command comprises analyzing the dialog to determine which of a variety of applications is necessary to complete the task. (Leber-Paragraph 78, Paragraph 91)

Leber disclosed (re. Claim 6,44) utilizing the specialized entity to participate in dialog interaction with the user to guide the user in the production of said dialog. (Leber-Paragraph 204-205)

Leber disclosed (re. Claim 15,34,52) wherein the communication service is an instant message communication service, and wherein receiving dialog from the user comprises receiving instant message dialog. (Leber-Paragraph 67, '*chat box*' )

Leber disclosed (re. Claim 16,35,53) wherein the dialog is directed to a specialized buddy appearing on an instant messaging buddy list associated with the user. (Leber-Paragraph 267)

Leber disclosed (re. Claim 17,36,54) wherein the communication service is a text

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messaging communication service, and wherein receiving dialog from the user comprises receiving text messaging dialog. (Leber-Paragraph 67, '*chat box*' )

Leber disclosed (re. Claim 18,37,55) wherein the communication service is an email transport service, and wherein receiving dialog from a user comprises receiving an email addressed to the specialized recipient. (Leber-Paragraph 67, '*chat box*' )

Leber disclosed (re. Claim 19) wherein analyzing the dialog to identify a command comprises parsing a textual content of the email. (Leber-Paragraph 43 )

Leber disclosed (re. Claim 21) wherein analyzing the dialog to identify a command comprises analyzing the dialog to identify a keyword. (Leber-Paragraph 43 )

Leber disclosed (re. Claim 22,23) performing a task on the user's behalf based on the command. (Leber-Paragraph 67)

Leber disclosed (re. Claim 24,59) wherein performing a task on the user's behalf comprises interfacing with a calendar software application. (Leber-Paragraph 105)

Leber disclosed (re. Claim 25,41) wherein execution of the command is contingent upon a set of predetermined circumstances, and wherein performing a task on the user's behalf comprises performing a task when the predetermined set of circumstances have occurred. (Leber-Paragraph 253, '*a periodic reminder*' )

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5,7-14, 28-33, 45-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leber (US Publication 2003/0182391) in view of Yairi (US Publication 2004/0078424).

While Leber substantially disclosed the invention as claimed, Leber did not disclose (re. Claim 3) determining whether the user is authorized to utilize the application necessary to complete the task, and performing the task only if the user is authorized.

Yairi disclosed (re. Claim 3) determining whether the user is authorized to utilize the application necessary to complete the task, and performing the task only if the user is authorized. (Yairi-Paragraph 50)

Leber and Yairi are analogous art because they present concepts and practices regarding presentation of web services via IM to a mobile user. At the time of the invention it would have been obvious to a person of ordinary skill in the networking art to combine Yairi into Leber. The motivation for said combination would have been to overcome the shortcomings of SMS (Yairi-Paragraph 7).

Leber-Yairi disclosed (re. Claim 4) presenting the user with an opportunity to become authorized when the user is not authorized to utilize the application necessary to complete the task. (Yairi-Paragraph 40, *'composite service offered to the user'*, Paragraph 49)

Leber-Yairi disclosed (re. Claim 5) wherein presenting the user with an opportunity to become authorized comprises presenting the user with an opportunity to purchase access. (Yairi-Paragraph 40, *'composite service offered to the user'*, Paragraph 49)

While Leber substantially disclosed the invention as claimed, Leber did not disclose (re. Claim 7) wherein utilizing the specialized entity to participate in dialog



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interaction with the user comprises: presenting the user with a plurality of choices; and receiving from the user a selection of one of the plurality of choices.

Leber-Yairi disclosed (re. Claim 7,28,45) wherein utilizing the specialized entity to participate in dialog interaction with the user comprises: presenting the user with a plurality of choices; and receiving from the user a selection of one of the plurality of choices. (Yairi-Paragraph 30)

Leber and Yairi are analogous art because they present concepts and practices regarding presentation of web services via IM to a mobile user. At the time of the invention it would have been obvious to a person of ordinary skill in the networking art to combine Yairi into Leber. The motivation for said combination would have been to overcome the shortcomings of SMS (Yairi-Paragraph 7).

Leber-Yairi disclosed (re. Claim 8,29,46) wherein performing a task on the user's behalf comprises performing a task tailored to the selection of one of the plurality of choices. (Leber-Paragraph 91)

While Leber substantially disclosed the invention as claimed, Leber did not disclose (re. Claim 9,30) performing a task tailored to a parameter listed in a profile associated with the user; (re. Claim 10,31,47) performing a task tailored to a preference associated with the user; (re. Claim 11,32,48) wherein the preference is set by the user; (re. Claim 12,33,49) wherein the preference is automatically set based on a history of user interactions with the specialized entity.

Yairi disclosed (re. Claim 9, 10, 11, 12, 30, 31, 32, 33, 47, 48, 49) performing a task tailored to a parameter listed in a profile associated with the user; (Yairi-Paragraph 33, *'obtains any necessary parameters from the IM client', Paragraph 43*) Yairi disclosed (re. Claim 12, 33, 49) wherein the preference is automatically set based on a history of user interactions with the specialized entity. (Yairi-Paragraph 33, *'obtains any necessary parameters from the IM client', Paragraph 43*)

Leber and Yairi are analogous art because they present concepts and practices regarding presentation of web services via IM to a mobile user. At the time of the invention it would have been obvious to a person of ordinary skill in the networking art to combine Yairi into Leber. The motivation for said combination would have been to overcome the shortcomings of SMS (Yairi-Paragraph 7).

While Leber substantially disclosed the invention as claimed, Leber did not disclose (re. Claim 13, 50) determining a geographic location of a device with which the user is communicating with the communication service; (re. Claim 14, 51) performing a task on the user's behalf comprises performing a task tailored to the geographic location.

Yairi disclosed (re. Claim 13, 14, 50, 51) determining a geographic location of a device with which the user is communicating with the communication service. (Yairi-Paragraph 34, *'alerting to traffic information subsequent to providing driving directions (optionally further based on a location of the mobile terminal)'*)

Leber and Yairi are analogous art because they present concepts and practices regarding presentation of web services via IM to a mobile user. At the time of the invention it would have been obvious to a person of ordinary skill in the networking art to combine Yairi into Leber. The motivation for said combination would have been to overcome the shortcomings of SMS (Yairi-Paragraph 7).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-12,20, 30-33, 38, 47-49,56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leber (US Publication 2003/0182391) in view of Kennewick (US Publication 2004/0193420).

While Leber substantially disclosed the invention as claimed, Leber did not disclose (re. Claim 9,30) performing a task tailored to a parameter listed in a profile associated with the user; (re. Claim 10,31,47) performing a task tailored to a preference associated with the user; (re. Claim 11,32,48) wherein the preference is set by the user;

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(re. Claim 12,33,49) wherein the preference is automatically set based on a history of user interactions with the specialized entity.

Kennewick disclosed (re. Claim 9, 10, 11,12,30,31,32,33,47,48,49) performing a task tailored to a parameter listed in a profile associated with the user;(Kennewick-Paragraph 11, '*user specific profile data*'). Kennewick disclosed (re. Claim 12,33,49) wherein the preference is automatically set based on a history of user interactions with the specialized entity. (Kennewick – Paragraph 32)

Leber and Kennewick are analogous art because they present concepts and practices regarding presentation of web services via IM to a mobile user. At the time of the invention it would have been obvious to a person of ordinary skill in the networking art to combine Kennewick into Leber. The motivation for said combination would have been to allow for natural language speech queries or commands in a vehicular environment. (Kennewick-Paragraph 6)

While Leber substantially disclosed the invention as claimed, Leber did not disclose (re. Claim 20,38,56) wherein the communication service is an automated telephone system, and wherein receiving dialog from a user comprises receiving speech communication.

Kennewick disclosed (re. Claim 20,38,56) wherein the communication service is an automated telephone system, and wherein receiving dialog from a user comprises receiving speech communication. (Kennewick-Paragraph 76)

Leber and Kennewick are analogous art because they present concepts and practices regarding presentation of web services via IM to a mobile user. At the time of the invention it would have been obvious to a person of ordinary skill in the networking art to combine Kennewick into Leber. The motivation for said combination would have been to allow for natural language speech queries or commands in a vehicular environment. (Kennewick-Paragraph 6)

### ***Conclusion***

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

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In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

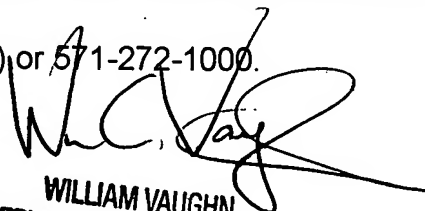
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Bengzon whose telephone number is (571) 272-3944. The examiner can normally be reached on Mon. thru Fri. 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571)272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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